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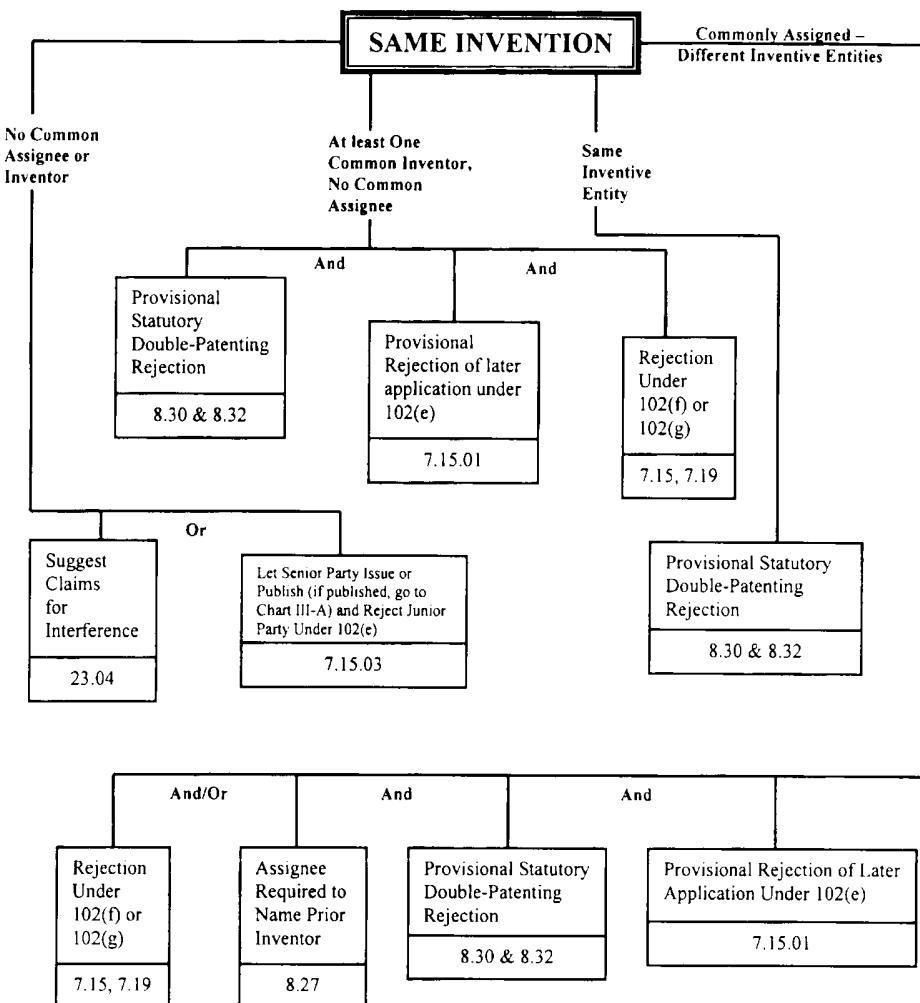
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**CONFLICTING CLAIMS BETWEEN:  
TWO APPLICATIONS \***

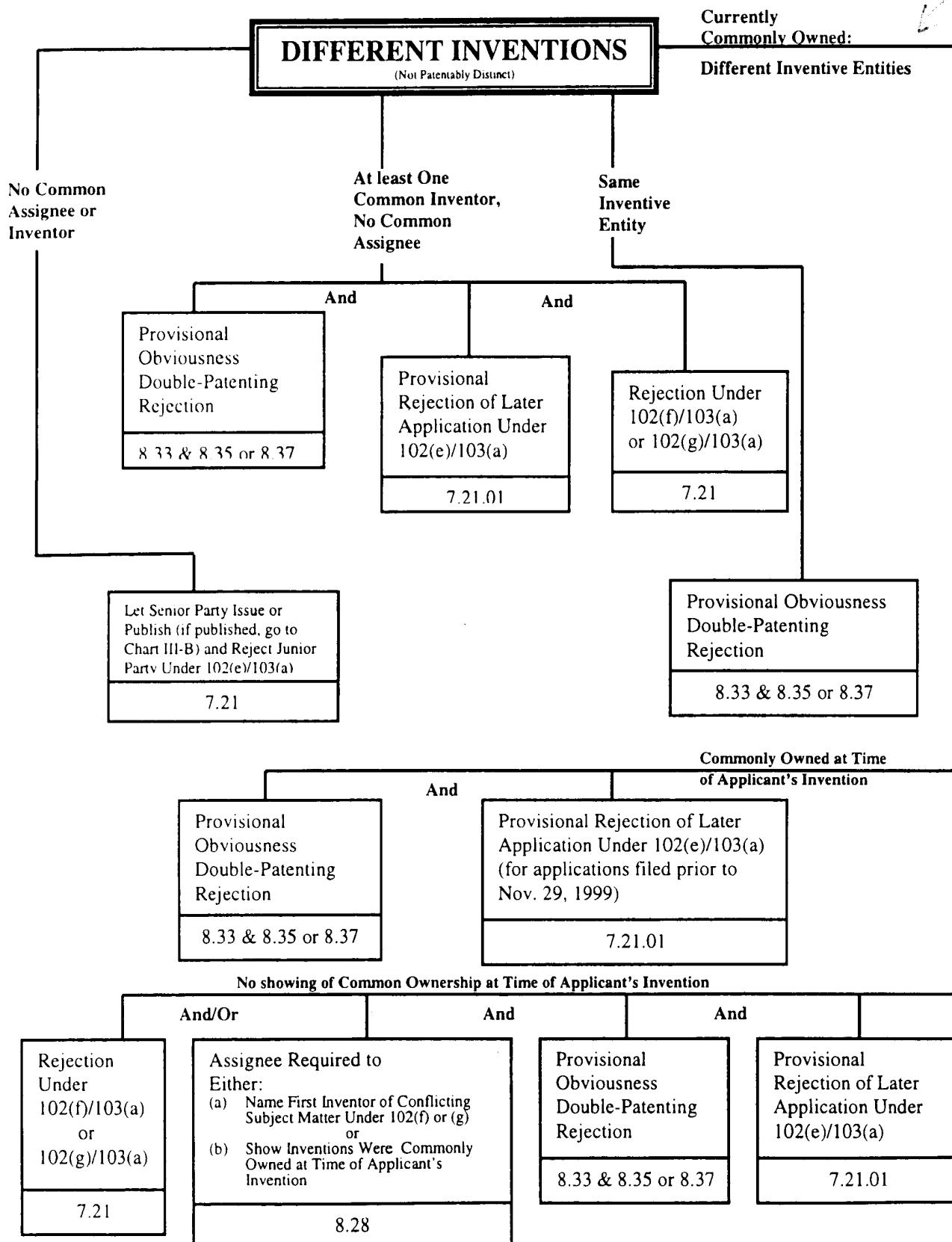
CHART I-A



\* This chart applies where the application being applied as a reference has NOT been published.

**CONFLICTING CLAIMS BETWEEN:  
TWO APPLICATIONS \***

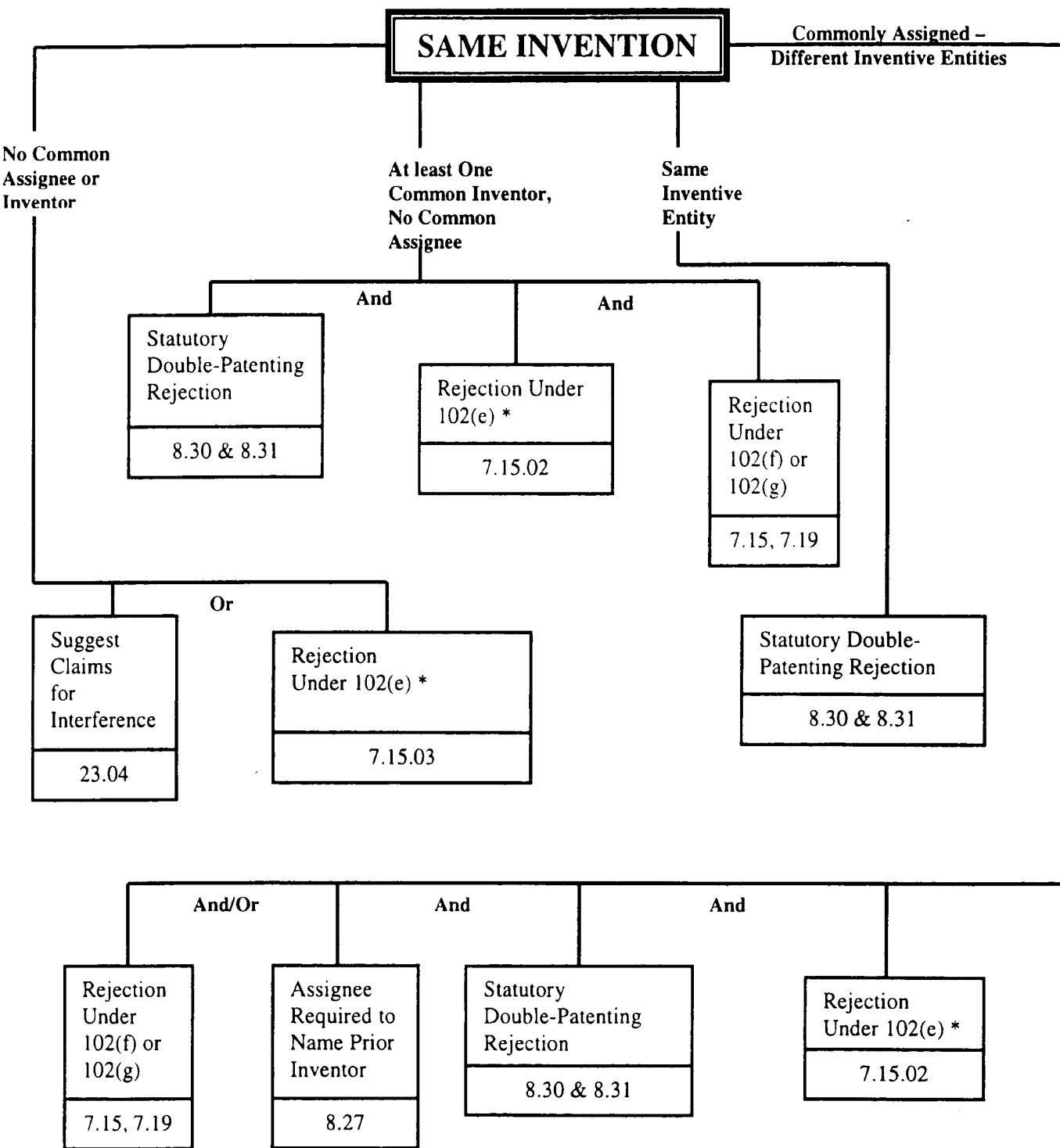
**CHART I-B**



\* This chart applies where the application being applied as a reference has NOT been published.

## CONFLICTING CLAIMS BETWEEN: APPLICATION AND A PATENT

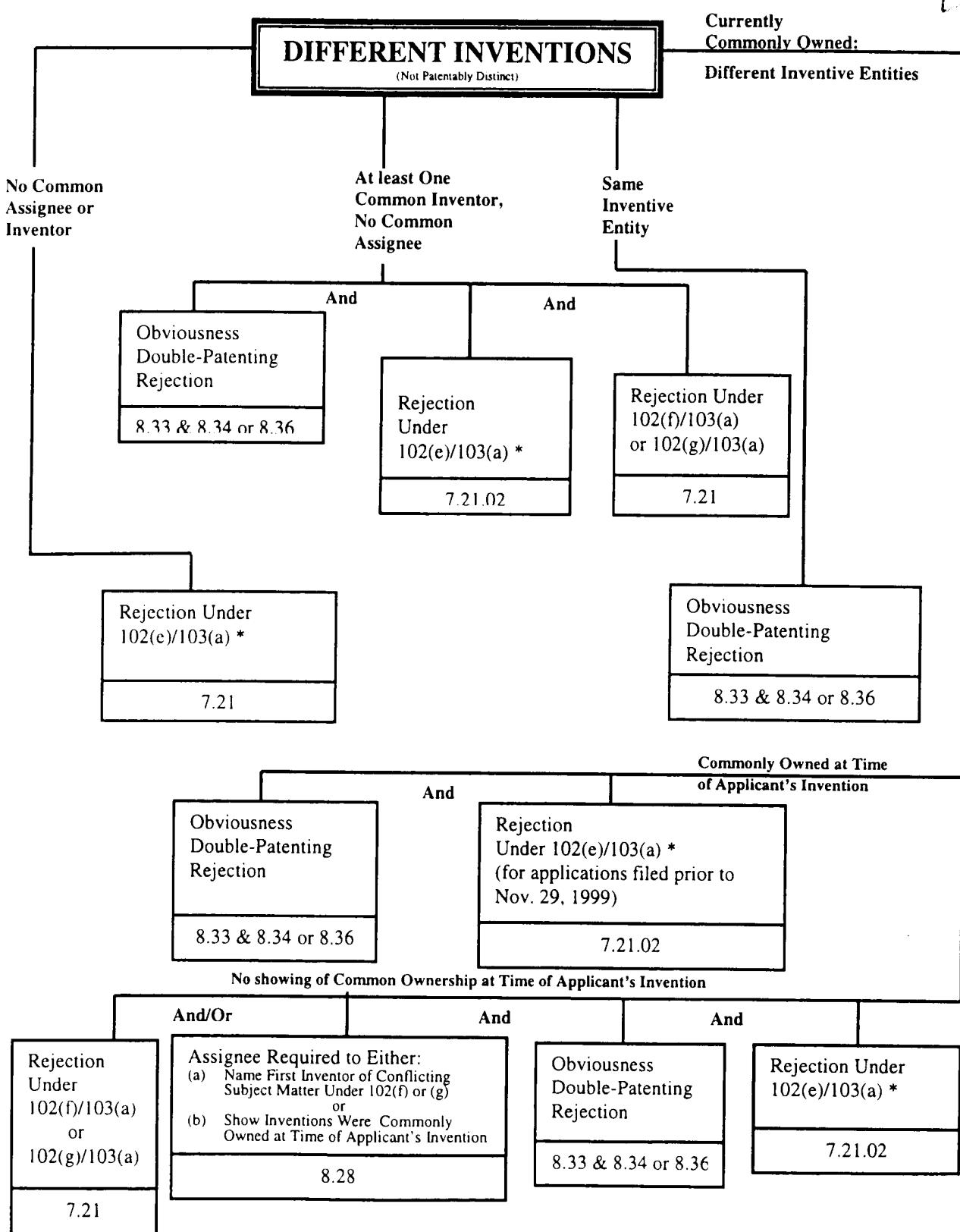
CHART II-A



\* A rejection under 35 U.S.C. 102(e) would NOT be appropriate where the application being examined was filed on or after Nov. 29, 2000 or filed prior to Nov. 29, 2000 and voluntarily published, and the reference patent issued from an international application (reference patent has no 102(e) prior art effect).

**CONFLICTING CLAIMS BETWEEN:  
APPLICATION AND A PATENT**

**CHART II-B**



\*The reference patent would NOT be prior art under 35 U.S.C. 102(e) where the patent issued from an international application and the application being examined was filed on or after Nov. 29, 2000 or filed prior to Nov. 29, 2000 and voluntarily published.

A double patenting rejection of the obviousness-type is “analogous to [a failure to meet] the nonobviousness requirement of 35 U.S.C. 103” except that the patent principally underlying the double patenting rejection is not considered prior art. *In re Braithwaite*, 379 F.2d 594, 154 USPQ 29 (CCPA 1967). Therefore, any analysis employed in an obviousness-type double patenting rejection parallels the guidelines for analysis of a 35 U.S.C. 103 obviousness determination. *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985).

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. 103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103 are employed when making an obvious-type double patenting analysis. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue;
- (B) Determine the differences between the scope and content of the patent claim and the prior art as determined in (A) and the claim in the application at issue;
- (C) Determine the level of ordinary skill in the pertinent art; and
- (D) Evaluate any objective indicia of nonobviousness.

The conclusion of obviousness-type double patenting is made in light of these factual determinations.

Any obviousness-type double patenting rejection should make clear:

- (A) The differences between the inventions defined by the conflicting claims — a claim in the patent compared to a claim in the application; and
- (B) The reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent.

When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art. This does not mean that one is precluded from all use of the patent disclosure.

The specification can always be used as a dictionary to learn the meaning of a term in the patent claim. *In re Boylan*, 392 F.2d 1017, 157 USPQ 370 (CCPA 1968). Further, those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 441-42, 164 USPQ 619, 622 (CCPA 1970). The court in *Vogel* recognized “that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim,” but that one can judge whether or not the invention claimed in an application is an obvious variation of an embodiment disclosed in the patent which provides support for the patent claim. According to the court, one must first “determine how much of the patent disclosure pertains to the invention claimed in the patent” because only “[t]his portion of the specification supports the patent claims and may be considered.” The court pointed out that “this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined.”

This paragraph must be preceded by form paragraph 8.30 and is used only for double patenting rejections of the same invention claimed in an earlier patent; that is, the "scope" of the inventions claimed is identical.

2.

If the conflicting claims are in another copending application, do not use this paragraph. A provisional double patenting rejection should be made using paragraph 8.32.

3.

Do not use this paragraph for non-statutory-type double patenting rejections. If non-statutory type, use appropriate form paragraphs 8.33 to 8.39.

4.

This paragraph may be used where the conflicting patent and the pending application are:

(a)

by the same inventive entity, or

(b)

by a different inventive entity and are commonly assigned even though there is no common inventor, or

(c)

not commonly assigned but have at least one common inventor.

5.

In bracket 3, insert the number of the conflicting patent.

6.

If the patent is to a different inventive entity and is commonly assigned with the application, paragraph 8.27 should additionally be used to require the assignee to name the first inventor.

7.

If evidence is of record to indicate that the patent is prior art under either 35 U.S.C. 102(f) or (g), a rejection should also be made using paragraphs 7.15 and/or 7.19 in addition to this double patenting rejection.

8.

If the patent is to a different inventive entity from the application and the effective U.S. filing date of the patent antedates the effective filing date of the application, a rejection under 35 U.S.C. 102(e) should additionally be made using form paragraph 7.15.02.

#### **¶ 8.32 Provisional Rejection, 35 U.S.C. 101, Double Patenting**

Claim [ 1 ] provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim [ 2 ] of copending Application No. [ 3 ]. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

#### **Examiner Note**

1.

This paragraph must be preceded by form paragraph 8.30 and is used only for double patenting rejections of the same invention claimed in another copending application; that is, the scope of the claimed inventions is identical.

2.

If the conflicting claims are from an issued patent, do not use this paragraph. See paragraph 8.31.

3.

Do not use this paragraph for non-statutory-type double patenting rejections. See paragraphs 8.33 to 8.39.

4.

This paragraph may be used where the conflicting claims are in a copending application that is:

- (a) by the same inventive entity, or
- (b) by a different inventive entity and is commonly assigned even though there is no common inventor, or
- (c) not commonly assigned but has at least one common inventor.

5. Paragraph 8.28 may be used in place of or along with this paragraph to resolve any remaining issues relating to priority under 35 U.S.C. 102(f) or (g).

- 6. In bracket 3, insert the number of the conflicting application.
- 7. A provisional double patenting rejection should also be made in the conflicting application.
- 8. If the copending application is by a different inventive entity and is commonly assigned, paragraph 8.27 should additionally be used to require the assignee to name the first inventor.

9. If evidence is also of record to show that either application is prior art unto the other under 35 U.S.C. 102(f) or (g), a rejection should also be made in the other application using paragraphs 7.15 and/or 7.19 in addition to this provisional double patenting rejection.

10. If the applications do not have the same inventive entity and effective U.S. filing date, a provisional 102(e) rejection should additionally be made in the later-filed application using paragraph 7.15.01.

If the “same invention” is not being claimed twice, an analysis must be made to determine whether a nonstatutory basis for double patenting exists.

## B. Nonstatutory Double Patenting

A rejection based on nonstatutory double patenting is based on a judicially created doctrine grounded in public policy so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re White*, 405 F.2d 904, 160 USPQ 417 (CCPA 1969); *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); *In re Sarett*, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964).

### 1. Obviousness-Type

In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is — does any claim in the application define an invention that is merely an obvious variation of an invention claimed in the patent? If the answer is yes, then an “obviousness-type” nonstatutory double patenting rejection may be appropriate.

Obviousness-type double patenting requires rejection of an application claim when the claimed subject matter is **not patentably distinct** from the subject matter claimed in a commonly owned patent when the issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent. See *Eli Lilly & Co. v. Barr Labs., Inc.*, 251 F.3d 955, 58 USPQ2d 1865 (Fed. Cir. 2001); *Ex parte Davis*,

This paragraph must be preceded by form paragraph 8.30 and is used only for double patenting rejections of the same invention claimed in an earlier patent; that is, the "scope" of the inventions claimed is identical.

2.

If the conflicting claims are in another copending application, do not use this paragraph. A provisional double patenting rejection should be made using paragraph 8.32.

3.

Do not use this paragraph for non-statutory-type double patenting rejections. If non-statutory type, use appropriate form paragraphs 8.33 to 8.39.

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If the “same invention” is not being claimed twice, an analysis must be made to determine whether a nonstatutory basis for double patenting exists.

## B. Nonstatutory Double Patenting

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